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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/394,264	09/10/99	MORTON	C 10286/008001
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HM12/0522

EXAMINER

WINKLER, U

ART UNIT

PAPER NUMBER

1645

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DATE MAILED:

05/22/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/394,264

Applicant(s)

MORTON ET AL.

Examiner

Ulrike Winkler, Ph.D.

Art Unit

1645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claims 1-28 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some * c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) ____.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-7 and 18, drawn to nucleic acids, vectors containing nucleic acids and a kit, classified in class 536, subclass 23.1.
- II. Claims 8-10, drawn to a protein, classified in class 530, subclass 350.
- III. Claims 11 and 15, drawn to an antibody, classified in class 530, subclass 389.1.
- IV. Claim 12, drawn to a method of making a polypeptide, classified in class 435, subclass 91.1.
- V. Claims 13, 14, 27 and 28, drawn to a method of detecting a polypeptide, classified in class 435, subclass 7.1.
- VI. Claims 15, 17, 25 and 26, drawn to a method of detecting a nucleic acid, classified in class 935, subclass 78.
- VII. Claims 19-22, drawn to a method of identifying compounds that bind the polypeptide, classified in class 436, subclass 501.
- VIII. Claims 23 and 24, drawn to a method of treatment, classified in class 424, subclass 9.1.

The inventions are distinct, each from the other because of the following reasons:

Groups I-III are compositions and are distinct from groups IV-VIII which are drawn to methods. Groups I-III are compositions and each is distinct from the other because they contain different materials. Group I comprises the DNA sequence for the protein; and DNA is made up of nucleic acids. Group II is the protein and therefore is made up of amino acids. Group III

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comprises an antibody to the protein, although antibodies themselves are proteins, they are different molecules with different structures. Though there may be overlap for these groups, the search for one group will not be coextensive with that of the other group.

Groups IV–VIII are drawn to methods and each is distinct from the other because they utilize different starting materials, therefore the outcomes are not be expected to be the same. Groups IV is a method of making a protein. Group V is a method of detecting a protein. Group VI is a method of detecting nucleic acids. Group VII is a method identifying compounds that bind the polypeptide. Group VIII is a method of treating a subject. The methods differ from each other by utilizing different starting materials and techniques, the outcome would therefore not be expected to be the same.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for one group would not be coextensive for the other groups, restriction for examination purposes as indicated is proper.

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ulrike Winkler, Ph.D. whose telephone number is 703-308-8294. The examiner can normally be reached M-F, 8:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached at 703-308-3995.

The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for informal communications use 703-308-4426.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.



Ulrike Winkler, Ph.D.



JEFFREY STUCKER
PRIMARY EXAMINER